

REMARKS

Status of the Claims

Claims 1-3 and 5-13 are currently pending in the application. Claims 1-3 and 5-13 stand rejected. Claims 1 and 2 have been amended without prejudice or disclaimer. No new matter has been added by way of the present amendments. Specifically, the amendment to claim 1 is supported by the specification at, for instance, page 6, line 25 to page 7, line 5, listing several exemplary embodiments which include the claimed diphenylmethylamino structure. The amendment of claim 2 is supported by the specification at, for instance, page 6, lines 25-28. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (See, Office Action of July 2, 2008, at page 2, hereinafter, "Office Action"). Applicants traverse the rejection as set forth herein.

The Examiner states that the term "benzophenoneimine" is unclear.

Although Applicants do not agree that this term is unclear, to expedite prosecution, claim 1 has been amended to replace the term "benzophenoneimine" for R' and R" in claim 1 with "diphenylmethylamino." In addition, claim 2 has been amended to replace the term "aryl" for R6 and R7 with the term "phenyl" to be consistent with the amendment of claim 1.

Since no specific reasoning is provided for the rejection of claim 13, claim 13 is believed to be definite for, *inter alia*, depending from a definite base claim, amended claim 1.

Reconsideration and withdrawal of the indefiniteness rejection of claims 1 and 13 are respectfully requested.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-3 and 5-13 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. (*See*, Office Action, at pages 3-33). Applicants traverse the rejection as set forth herein.

The Examiner cites to an extremely long laundry list of diseases, including cancers, viral infections, etc., which are entirely unrelated to the presently claimed invention. (*Id.* at pages 3-26). The Examiner then asserts that the “specification also refers to use as an intermediate, but since the specification does not say what the compounds are an intermediate for, this is of no value.” (*Id.* at page 26). At page 27 of the Office Action, the Examiner states there are no working examples. Finally, at page 31, the Examiner states that Applicants’ prior comments of April 30, 2008 were unpersuasive. (*Id.* at page 31). The Examiner states that “a single enabling utility is all that compounds need.” (*Id.*). The Examiner then states that the teachings of the specification require undue experimentation. (*Id.*).

However, Applicants wish to point out to the Examiner that what is being sought to be patented is not a method of use. Rather, Applicants seek a patent covering the claims of the present invention, which are directed to compounds, not viruses, cancers, or treatment thereof. The Examiner sets forth no reasoning that supports rejection of the presently pending compound claims. The Examiner requires Applicants to name a cancer or virus. (*Id.* at page 32). This request has not been addressed because Applicants’ claims are not directed to any cancers or

viruses. Applicants are not required to enable cancers or viruses, isolated or otherwise, since these limitations are not encompassed by the presently pending claims. The Examiner is respectfully referred to the presently pending claims, 1-3 and 5-13, which are directed to compounds and methods of producing compounds, not viruses, cancers, or any other type of disease.

The Examiner admits that Applicants' application is directed to compounds, not viruses or cancers. (*Id.* at page 32, lines 8-9). The Examiner states that "most compound claims i.e. 2, 3, 5-8 don't even permit a phenyl!" (*Id. emphasis in original*). Applicants find this contention equally unsupportable, since the specification is replete with examples of compounds containing phenyl groups. In fact, the present claim 2 has been amended to explicitly recite a phenyl group.

The Examiner refers to treatment of viruses and cancers. However, the Examiner is again respectfully requested to consider the language of claims 1-3 and 5-13. None of these claims is directed to treatment of any kind. The pending claims are directed to compounds and their synthesis. If the Examiner disagrees, the Examiner is invited to point out where Applicants have claimed treatment of diseases.

Since this rejection is clearly not related to utility, Applicants insist that the presently claimed invention, directed to compounds, is fully enabled.

The original claims relate to a compound and a production method thereof, where the enablement of the claims should be judged based on the enforceability of the claimed invention itself. The presently claimed invention relates to a compound *per se*, rather than any treatment method of a diseases. Accordingly, as long as the specification teaches those of ordinary skill in the art a method of producing the compound (how to make) and how the compound can be used

by those of ordinary skill in the art (how to use – not at issue here since there is no utility rejection), the enablement requirement is satisfied.

It is respectfully submitted that inasmuch as the compound and the production method of the presently claimed invention are sufficiently described in the specification, the holding of the Examiner is clearly incorrect.

Further, an explicit production method of the compound of the presently claimed invention may be found in the Examples of WO 00/75158, which is itself described at page 1 of the present specification. (*See also*, Capek et al., *J. Org. Chem.*, 70:8005, 2005, copy attached hereto as Exhibit A). Therefore, there is clearly no undue experimentation required by one of skill in the art to obtain the presently claimed compounds.

More specifically, claims 9-12 are directed to methods of producing the presently claimed compounds, not treatment methods. Since the methods of production are described in the present specification in a manner in which one of skill in the art can comprehend and duplicate in the laboratory, it is clear that there are not grounds upon which the Examiner can reject the presently claimed invention under 35 U.S.C. § 112.

Thus, reconsideration and withdrawal of the enablement rejection of claims 1-3 and 5-13 are respectfully requested.

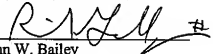
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: SEP 30 2008

Respectfully submitted,

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Attachment: Exhibit A - Capek et al., *J. Org. Chem.*, 70:8005, 2005